

REMARKS

This Amendment and Response is submitted in response to the Office Action mailed May 17, 2005.

Amendments to the Claims and Support

Applicant has amended claims 1, 4, 5, 7-9, 11, 14, 15, 17-19, 21-24, 28, 31, 32, 34-36, 40 and 41. Support for the amended claims are provided in paragraphs 18 and 19, and Figure 3 of the specification. Upon entry of the amendments, the application contains claims 1-44 pending and under consideration.

Claim Objections

The Office Action objects to claims 5, 15, and 32 because these claims include the limitation that the reinforcing mechanism “resides below the internal surface of the tube.” The Office Action states that it is unclear to which direction “below” refers and further states that “below” is understood to refer to the direction radially within the internal surface of the external segment. Applicant has amended claims 5, 15, and 32 to clarify that the reinforcing mechanism resides below the internal surface of the external segment in a direction radially within the internal surface of the external segment.

The Office Action objects to claims 4, 5, 14, 15, 31 and 32 because they include the limitation “the tube” and suggests that this be changed to “the external segment.” Applicant has amended claims 4, 5, 14, 15, 31, and 32 to replace “the tube” with “the external segment.”

The Office Action objects to claims 14 and 31 because of the limitation “internal segment” and suggests that this be changed to “external segment.” Applicant has amended claims 14 and 31 to replace “internal segment” with “external segment.”

The Office Action objects to claims 14, 21, 22, and 31, stating that the limitations “internal segment”, “locking mechanism”, and “internal mechanism” should be changed to “inner segment,” “locking pin,” and “inner segment” respectively. Applicant has amended claims 14, 21, 22, and 31 accordingly.

The Office Action objects to claims 7, 17, 23, 34, and 40 because of their inclusion of the term “certain material”. Applicant has amended claims 7, 17, and 34 to clearly refer to an external segment constructed using a first material and a reinforcing materials constructed using a second material, where the second material is stronger than the first material. Applicant has amended claims 23 and 40 to clearly refer to an external segment comprising a first material and a locking pin comprising a second material where the second material is stronger than the first material.

Accordingly, Applicant requests withdrawal of the objection as to amended claims 4, 5, 7, 14, 15, 17, 21, 22, 23, 31, 32, 34, and 40.

The Rejection of Claims Under 35 U.S.C. § 103(a)

The Office Action rejects Claims 1, 2, 4-7, 10-12, 14-17, 20-22, 25-29, 31-34, 37-39, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0095745 to Wang (“Wang”) in view of U.S. Patent No. 1,031,024 to Pickles (“Pickles”).

The Office Action states that Wang discloses a telescoping handle for a transporting device having an external segment (30) with a hole (35) configured to receive a locking pin (22) and an inner segment (20) with the locking pin (22). The Office Action recognizes that Wang fails to teach a reinforcing mechanism. The Office Action states that Pickles teaches a material with a hole, where the hole includes a reinforcement

mechanism (12, 20). The reinforcing mechanism inherently distributes forces imparted by a member passing through it. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wang as taught by Pickles, such that a reinforcement mechanism is included in the holes (35) of Wang, to prevent damage to the tube, or external member.

Applicant respectfully traverses this rejection because Wang and Pickles, either alone or in combination, fails to teach all of the limitations of amended independent claims 1, 11, and 28.

Amended, independent claim 1 recites an external segment of a telescoping handle which includes a hole configured to receive a locking pin and a reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

Amended, independent claim 11 recites a telescoping handle which includes an inner segment and an external segment. The inner segment includes a locking pin. The external segment includes a hole configured to receive the locking pin, and a reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

Amended, independent claim 28 recites a transporting device, which includes a telescoping handle. The telescoping handle comprises an inner segment and an external segment. The inner segment includes a locking pin. The external segment includes a hole configured to receive the locking pin, and a reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

Wang teaches a retractable handle device for a suitcase with a microadjustable structure for adjusting to different lengths. The handle includes a pair of conduits (10) for attaching to the suitcase, a pair of tubes (20) slidably received within the conduits, and a pair of sleeves (30) received and engaged between the conduits (10) and the tubes (20). (¶¶ 23 and 24) Each sleeve (30) includes two semicylindrical members (300) and a number of holes (35) formed therein. The tubes (20) have one or more latches (21) each including one or more catches (22) for engaging through the holes (35) for adjustably securing the tube (20) to the sleeve (30) and subsequently to the conduit (10) for microadjusting the tube (20) relative to the sleeve (30) and the conduit (10). (¶ 25).

Wang, however, does not teach or suggest providing any reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

Pickles describes a washer and a grommet provided within the washer. Pickles teaches the use of a grommet with the washer for setting in a sheet material, such as rubber goods, hammocks, awnings, and other textile articles. Although the grommet as taught by Pickles may reinforce the hole provided in such sheet material, such grommet would not be sized and shaped to receive any locking pin of a telescoping handle or a similar structure and would not be configured to reinforce the hole of an external segment of a telescoping handle in such a manner as to distribute forces imparted by the locking pin.

Since, neither Wang nor Pickles teaches or suggests every element of amended claims 1, 11, or 28, Applicant submits that amended independent claims 1, 11, and 28, and the claims which depend from these independent claims are patentable over Wang in view of Pickles.

Moreover, when relying on several references, it is incumbent upon the Examiner to identify some suggestion to combine the references. In re Mayne, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997). Obviousness cannot be established by simply combining the references, absent some suggestion or teaching within the references supporting the combination. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). “It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.” Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990)(emphasis added). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. MPEP §2143.01 (citing Al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)).

Most if not all inventions arise from a combination of old elements. In re Kotzab, 55 USPQ2d at 1316 (citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. In re Kotzab, 55 USPQ2d at 1316 (citing In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Applicant submits that there is no teaching, suggestion or motivation to combine the teachings of Wang with the teachings of Pickles. Wang fails to recognize that any

force may be exerted against the holes (35) provided along the sleeve (30) of the handle thereby causing those holes (35) to deform. Since Wang does not recognize this problem, one of ordinary skill in the art would have no motivation to look for a solution to such problem based on his or her study of the teachings and without such motivation, there would be no reason to combine the teachings of Pickles with the teachings of Wang.

The Office Action rejects Claims 8, 18, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34 above, and further in view of U.S. Patent No. 5,984,064 to Byington ("Byington").

Claim 8 includes all of the limitations of independent claim 1 and further recites that the first material is aluminum. Claim 18 includes all of the limitations of independent claim 11 and further recites that the first material is aluminum. Claim 35 includes all of the limitations of independent claim 28 and further recites that the first material is aluminum. Therefore, each of claims 8, 18, and 35 require a reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

According to the Office Action, Byington teaches an extensible handle for a piece of luggage having external segments made of aluminum.

However, as discussed above, neither Wang nor Pickles teaches or suggests providing a reinforcing mechanism sized and shaped to receive a locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin. Although Byington teaches a telescoping handle having an external segment made of aluminum, Byington also fails to teach or suggest providing a reinforcing mechanism sized and shaped to receive a locking pin and configured to reinforce the hole as recited in these claims. Since these references, alone or in combination, fail to teach or

suggest all of the limitations of claims 8, 18, and 35, Applicant submits that claims 8, 18, and 35 are patentable over Wang, in view of Pickles and further in view of Byington.

The Office Action rejects Claims 9, 19, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34 above, and further in view of Cheraso, U.S. Patent No. 6,125,513 to Cheraso ("Cheraso").

Claim 9 recites all of the elements of independent claims 1 (discussed above) and claim 7 and further recites that the second material is stainless steel. Claim 19 recites all of the elements of independent claim 11 (discussed above) and claim 17 and further recites that the second material is stainless steel. Claim 36 recites all of the elements of independent claim 28 (discussed above) and claim 34 and further recites that the second material is stainless steel.

According to the Office Action, Pickles teaches the reinforcing mechanism to be made from sheet metal but does not specify stainless steel. Cheraso teaches a mechanism where a metal component is made from sheet metal, typically stainless steel.

Cheraso describes a portable device having a multi-function belt clip assembly. The leaf spring of the belt clip assembly is formed from sheet metal, typically stainless steel. (Col. 3, lines 4-6).

As discussed above, neither Wang nor Pickles teaches or suggests providing a reinforcing mechanism sized and shaped to receive a locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin. Cheraso also fails to teach or suggest a reinforcing mechanism sized and shaped to receive a locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin. In addition, there is no teaching, suggestion, or motivation to combine Wang and Pickles with Cheraso to provide a reinforcing mechanism made of

stainless steel, since Cheraso has nothing to do with a reinforcing mechanism and further does not provide any teaching or suggestion concerning the strength of stainless steel.

Since, these references, alone or in combination, fail to teach or suggest all of the limitations of claims 9, 19, and 36, Applicant submits that claims 9, 19, and 36 are patentable over Wang, in view of Pickles and further in view of Cheraso.

The Office Action rejects Claims 23, 24, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Pickles as applied to claims 11 and 28 above, and further in view of U.S. Patent No. 5,690,217 to Friday ("Friday").

The Office Action states that Friday teaches an extensible handle (60) with apertures (65,67) that receive a pin (75) of a locking mechanism (74) to secure the handle in a desired position, that the handle member (60) with apertures (65,67) is analogous to the external segment of the claims, and that the pin (75) is made of stainless steel and the handle member or external segment is made from plastic. Therefore, the locking pin (75) is made from a stronger material than the external segment.

Amended claim 23 recites all of the elements of independent claim 11 and further recites that the external segment comprises a first material, and that the locking pin comprises a second material that is stronger than the first material. Amended claim 24 recites all of the elements of claim 23 and further recites that the second material is stainless steel. Amended claim 40 recites all of the elements of independent claim 28 and further recites that the external segment comprises a first material, and that the locking pin comprises a second material that is stronger than the first material. Amended claim 41 comprises all of the elements of claim 40 and further recites that the second material is stainless steel.

Friday teaches a movable laundry storage with a handle unit. The handle unit is provided with a locking mechanism consisting of a pin member inserted through an aperture extending through the handle. The pin member may be constructed from any rigid material such as stainless steel and the handle member can be constructed from various rigid materials such including plastics or metal. (Col. 7, lines 54-59).

Applicant submits that Wang, Pickles, or Friday, either alone or in combination, fails to teach or suggest the claimed invention. None of these references teaches or suggests a reinforcing mechanism sized and shaped to receive the locking pin and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin. In addition, none of these references teaches or suggests that the material of the locking pin must be stronger than the material of the external segment. Friday merely teaches that both the pin member and the handle member should be constructed from a rigid material. However, Friday never teaches or suggests that the pin member material must be stronger than the handle member material. Therefore, Applicant submits that claims 23, 24, 40, and 41 are patentable over Wang in view of Pickles, and further in view of Friday.

The Office Action rejects Claims 1-3, 11-13, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of U.S. Patent No. 2,583,719 to White ("White") with respect to claims 1, 11, and 28.

The Office Action states that White teaches a material with a hole, where the hole includes a reinforcement mechanism. According to the Office Action, the reinforcement mechanism and the hole receive a member and prevent the material from being damaged by the member and inherently distribute forces imparted by the member. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the

invention to modify Wang as taught by White, such that a reinforcement mechanism is included in the holes of Wang to prevent damage to the tube or external member.

As discussed above, independent claims 1, 11, and 28 require a reinforcing mechanism sized and shaped to receive a locking pin of an inner segment of a telescoping handle and configured to reinforce the hole in such a manner as to distribute forces imparted by the locking pin.

As discussed above, Wang fails to teach or suggest such a reinforcement mechanism. White teaches a grommet, but one that is adapted to be mounted in glass or other easily broken material such as porcelain, hard rubber, plastics, painted or enameled sheets or the like. Although the grommet as taught by White may reinforce the hole provided in such fragile material, such grommet would not be sized and shaped to receive any locking pin of a telescoping handle or a similar structure and would not be configured to reinforce the hole of an external segment of a telescoping handle in such a manner as to distribute forces imparted by the locking pin.

Since Wang or White, either alone or in combination, fails to teach or suggest every element of amended claims 1, 11, and 28, Applicant submits that the amended claims 1, 11, and 28, and the claims which depend from these independent claims are patentable over Wang in view of White.

CONCLUSION

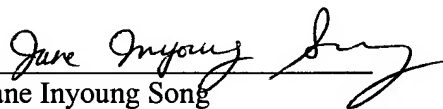
In view of the foregoing remarks, Applicant believe that the entire application is in condition for allowance and such action is respectfully requested. If it is believed that prosecution can be assisted thereby, the Examiner is invited to contact Applicant's undersigned representative at the below-listed telephone number.

Applicant hereby petitions for one-month extension of time up to and including September 17, 2005. Any required fee, not submitted with this Amendment and Response is to be charged to Deposit Account No. 50-2613. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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